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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,542	10/18/2001	Masami Shirai	P21224	5083
7055	7590	03/08/2005	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C.			NGUYEN, THONG Q	
1950 ROLAND CLARKE PLACE			ART UNIT	
RESTON, VA 20191			PAPER NUMBER	
			2872	

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/978,542

Applicant(s)

SHIRAI ET AL.

Examiner

Thong Q. Nguyen

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-8 and 10-29 is/are pending in the application.
- 4a) Of the above claim(s) 12-23, 25-27 and 29 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-7, 10, 11, 24 and 28 is/are allowed.
- 6) ☒ Claim(s) 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The present Office action is made in response to the amendment of Nov. 24, 2004. It is noted that in the mentioned amendment, applicant has canceled claim 9. The pending claims are now claims 4-8 and 10-29 (Claims 1-3 were canceled by the applicant in the amendment of 4/19/2004) in which claims 12-23, 25-27 and 29 are non-elected claims. Claims 4-8, 10-11, 24 and 28 are reexamined in this Office action.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kanai et al (U.S. Patent No. 5,668,674) in view of Kimura et al (Japanese reference No. 10-39121) (all of record).

Kanai et al disclose an image finder system having an objective lens system (11), an image erecting prism system (13) and an eyepiece lens system (14). In order to prevent the formation of ghost image, Kanai et al teach the formation of an extension section on the exit surface of the image erecting prism system. See columns 2-4 and figs. 1-7. The only feature missing from the art of Kanai et al is that it does not explicitly teach the extension section acting as a light shielding element for preventing the formation of ghost image is formed on the entrance surface of the image erecting prism system as claimed. However, the use of a light shielding element for preventing the formation of ghost image in an image

erecting prism system on the entrance surface and/or the exit surface of the image erecting prism system is suggested to one skilled in the art as can be seen in the finder provided by Kimura et al. In particular, the image erecting prism system as described in columns 7+ and shown in figures 3-4 comprises a light shielding element which is able to form on one entrance surface or the exit surface of the image erecting prism system for preventing the formation of ghost image made by off-axis light. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the finder provided by Kanai et al by utilizing the teaching, i.e., the formation of light shielding member on the entrance surface of an image erecting prism system, as suggested by Kimura et al for the purpose of providing a light shielding element on the entrance surface of the prism system to improve the ability of correction.

Allowable Subject Matter

4. Claims 4-7, 10-11, 24 and 28 are allowed over the cited art.

Response to Arguments

5. Applicant's arguments filed on 11/24/2004 have been fully considered but they are not persuasive.

Regarding to the rejection of claim 8 over the combination of art provided by Kanai et al (Patent No. 5,668,674) and Kimura et al (Japanese reference No. 10-39121), applicant's arguments provided in the amendment, pages 10-15, have been fully considered but they are not persuasive for the following reasons.

First, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Second, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Third, in response to applicant's arguments that the cited art does not features of the device claimed in the present claims, the Examiner respectfully disagrees with the applicant's opinions.

Regarding to the applicant's argument that the art of Kanai et al does not direct to a survey instrument comprising a sighting telescope (see amendment, page 11). The examiner offers the following opinions.

The claim 8 recites a survey instrument comprising a sighting telescope; however, the claim has not provided any specific limitations/features related to the structure of the so-called "survey instrument" and "sighting telescope" recited in the claim. Since the language of the claim should be considered in their broad interpreter then the optical device disclosed by Kanai et al is a survey instrument comprising a sighting telescope. Applicant should note that the user utilizing the device provided by Kanai et al will first look through the finder to survey the

screen or object before (s)he make a decision to take the picture or not. That is a process of survey and thus the device is a survey instrument. The finder constituting the device of Kanai et al comprises objective lens system, eyepiece lens system and image erecting prism system disposed between the objective lens and eyepiece lens system. The finder is able to view a distance object and able to form an intermediate image so the finder is a type of sighting telescope. In response to the applicant's argument that the art of Kanai et al does not disclose the use of a light shield device formed by an extended portion of the incident surface of the image erecting prism system. While the Examiner has agreed to the applicant's arguments; however, the claims are rejected under the combination of Kanai et al (U.S. Patent No. 5,668,674) in view of Kimura et al (Japanese reference No. 10-39121) in which one skilled in the art will modify the device provided by Kanai et al by using the extended portion containing a light shield element on the entrance surface of the image erecting prism system as suggested by Kimura et al for the purpose of increasing the ability of shielding harmful light to the image quality.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596

(Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the use of an erecting prism system having reflective surfaces which prism system has a similar structure as that disclosed in the present applicant is provided by the primary reference, i.e., Kanai et al, Patent '674. The secondary reference, i.e., Kimura et al, Japanese reference '121, is used in the combination to show that a light shielding mask can be used in either an entrance surface of a prism or an exit surface of a prism. As a result, one skilled in the art will recognize that (s)he can modify the optical device having an objective lens, an eyepiece, an erecting prism system located between the objective lens and the eyepiece which prism has an extension formed on the exit surface as provided by Kanai et al by arranging the extension section in the entrance surface as suggested by Kimura et al for the purpose of shielding light. Regarding to the feature related to the reflection of light as claimed, the formation of the extension section on the entrance surface of an erecting prism system of the combined product provided by Kanai et al and Kimura et al will provide a product which has the same structure of that of the device claimed and thus will inherently have the same result as those of the device claimed.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

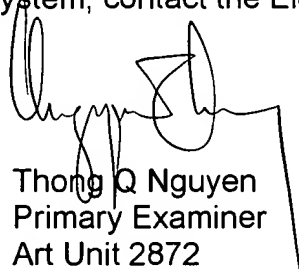
Art Unit: 2872

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q Nguyen
Primary Examiner
Art Unit 2872
